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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/090,354	03/04/2002	Jafferhusen Abdulhusen Ajani	LD0262NP	3877

23914 7590 08/07/2003

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EXAMINER

KRASS, FREDERICK F

ART UNIT PAPER NUMBER

1614

DATE MAILED: 08/07/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/090,354	AJANI ET AL.
	Examiner Frederick Krass	Art Unit 1614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 28 May 2003.

2a) This action is **FINAL**.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-13 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-11 and 13 is/are rejected.

7) Claim(s) 12 is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other: _____

### **Scope of Enablement Rejection**

Claims 1-11 and 13 were rejected under 35 U.S.C. 112, first paragraph as being broader in scope than their enabling disclosure.

This rejection is maintained.

Applicant argues that the experimentation necessary to determine enablement is not undue and that one skilled in the art "typically engages in such experimentation". The examiner finds no factual basis on this record for this assertion. Moreover, the section of the Brana decision cited by Applicant is not on point since it refers to testing for safety and efficacy, which is not required for a patent application but is rather the province of the FDA.

A fair reading of the Brana decision indicates that the case does not conflict with the position taken by the examiner. While the state of the art is relatively high with regard to the treatment of specific cancers with specific agents, it has long been underdeveloped with regard to the treatment of cancers broadly. In particular, there is no known anticancer agent which is effective against all cancers. This is why the National Cancer Institute (NCI) has the extensive *in vitro* drug screening program it does. As discussed by the court in In re Brana, 51 F.3d 1560 (Fed. Cir. 1995), *in vitro* assays are used by NCI (such as the P388 and L1210 lymphocytic leukemia tests at issue therein) to measure the potential antitumor properties of a candidate compound. Brana at 1562-63. If success is shown in this initial screening step, this demonstrates

that at least one cancer type (e.g., lymphocytic leukemia) is sensitive thereto, and provides the incentive to select it for further studies to determine its usefulness as a chemotherapeutic agent against other cancer types (lung, breast, colon, etc.) *Id.* at 1567-68. These *in vitro* tests are considered reasonably correlative of success *in vivo*.

Thus, the facts of record demonstrate that a considerable amount of *in vitro* empirical testing is required, with no *a priori* expectation of success being present, before a candidate anticancer agent can be considered useful against any particular cancer type.

Furthermore, the unpredictability observed with single agents is compounded when a combination of agents is used. This is summarized by WO 00/61142, at page 1, lines 17-23:

Combination therapies, while desirable, are a hit or miss proposition. The treatments are typically not additive. In many cases, cross effects and treatment load can result in lower effectiveness for the combinations, than either treatment alone.

This is verified by U.S. Pat. 6,465,448 at col. 1, lines 56-59:

The design of drug combinations for the chemotherapeutic treatment of cancer should be approached with the goals of 1) finding a combination that is synergistic with and not merely additive to the first compound with respect to the elimination of the tumor, and 2) finding a second drug that does not potentiate the toxic effects of the first therapeutic agent. *These conditions require a great deal of empirical testing of agents known to have anticancer properties with agents that either may have anticancer properties, or that may augment the first agent in other ways.* (Emphasis added).

Thus, the facts of record demonstrate that when two (or more) agents are used, even more additional empirical testing is required, again with no *a priori* expectation of success.

### **Obviousness Rejection**

Claims 1-5, 8 and 13 were rejected under 35 U.S.C. 103(a) as being unpatentable over Bissery in view of Junji et al.

This rejection is maintained.

Applicant argues that the examiner has used (impermissible) hindsight and that nothing in the art "impels" one to combine the teachings of the two references, nor does any reasonable expectation of success exist.

The examiner does not agree. The specific motivation (which would "impel" one to combine the prior art teachings, and which also provides the reasonable expectation of success) was detailed in the passage spanning pages 5 and 6 of the previous Office action. Surely reducing toxicity and improving therapeutic efficacy represent a strong impetus to one skilled in the art of chemotherapy.

### **Allowable Subject Matter**

Claim 12 remains objected to for the reasons detailed in the previous Office Action at page 6.

**Action is Final**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

**Correspondence**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frederick Krass whose telephone number is (703) 308-4335. The examiner can normally be reached on Monday, Tuesday and Thursday from 9am to 5pm, and on Friday from 11am to 7pm. The examiner is off Wednesday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Seidel, can be reached at (703) 308-4725. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Art Unit: 1614

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0193.

Frederick Krass  
Primary Examiner  
Art Unit 1614

